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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/347,525 07/06/99 OKU

M 103778

EXAMINER

IM22/0615

OLIFF & BERRIDGE PLC  
P O BOX 19928  
ALEXANDRIA VA 22320

KNABLE, G	PAPER NUMBER
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1733  
DATE MAILED:

06/15/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/347,525	Applicant(s) OKU ET AL.
	Examiner Geoffrey L. Knable	Art Unit 1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_ .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) 7 and 9-12 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-6, 8 and 13-15 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)  
17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5,6 . 20)  Other: \_\_\_\_\_

***El ction/R strictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9 and 13-15, drawn to a method of forming a laminated rubber member, classified in class 156, subclasses 117 and 184.
  - II. Claims 10-12, drawn to an apparatus for forming a laminated rubber member, classified in class 156, subclass 394.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice other materially different processes such as winding rubber strips without any overlapping or extruding thermoplastic resin materials rather than rubber.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species of the claimed invention:

- A: forming an innerliner;
- B: forming a tread;
- C: forming a filler/chafer/sidewall.

Art Unit: 1733

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Jacob Doughty (Reg. # 46,671) on May 30, 2001, a provisional election was made with traverse to prosecute the invention of group I, species B, claims 1-6, 8 and 13-15. Affirmation of this election must be made by

applicant in replying to this Office action. Claims 7 and 9-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 2, 5, 6, 8 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Deist (US 3,170,499).

Deist discloses forming a rubber laminate in a tire by helically winding a rubber strip, the strip initially including a first rubber material followed by a gradual blending with and eventual change to a second rubber material. Further, this material is applied to form at least three overlapping layers in the tire - note esp. cols. 1-2 and col. 4+. Further, although this reference is principally directed to the use of mills and calenders, at col. 7, lines 34-40, it is explicitly indicated that an extruder can be used in place of the mills/calenders, the feed to the extruder being controlled to adjust the compositions. Such thus satisfies the noted claims. Although the reference does not explicitly indicate that the rubber materials differ in "moduli" as claimed, the reference does clearly indicate that the materials have different properties and in fact soft and stiff rubbers are discussed at col. 1, lines 33-46. It seems therefore readily apparent or certainly obvious that such rubbers would or should differ in moduli as claimed in claims 1 and 6, it being additionally noted that it is well known to the ordinary artisan that different tread parts (e.g. base/cap/cushion) typically and commonly have different moduli.

With respect to claim 2, note that three layers with the intermediate layer formed from a blend of two different compositions is clearly contemplated - note col. 4, lines 69-72. With respect to claims 5 and 13, although Deist does not provide specifics of the

strip winding process, it would have been readily apparent to the ordinary artisan that the strip in Deist is or would or should be wound in overlapping form on the tire support, it being noted and considered that in strip winding of treads, adjacent edges of successive windings are almost always typically overlapped (as is well known), this therefore being either implicit or certainly obvious from the reference teachings. With respect to claim 8, Deist explicitly discloses the three mentioned layers for a tread.

11. Claims 3, 4, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deist (US 3,170,499).

With respect to claims 3 and 4, Deist indicates that it would be desirable to use many different rubber stocks each tailored for the specific location in the tire (col. 2, lines 11-17) and further that more than three stocks can be used if desired - col. 4, lines 72-75. To form more layers would thus have been obvious with the expectation of better being able to tailor the stock properties to the mechanical requirements in that particular position in the tire - only the expected results would therefore be achieved in any particular selection of a desired number of layers and stocks.

12. Claims 1, 2, 5, 6, 8 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Okada (US 6,039,826).

Okada teaches forming multilayer rubber tire components using a single extruder successively and continuously extruding and winding different rubber materials - note esp. figs. 8-11. Although this reference does not actually mix the rubber materials, but rather has a sharp demarcation between materials, it is not considered that the present claims define over this. In particular, note that the claims define that the blending ratio

Art Unit: 1733

can be "stepwise" increased. This is considered to reasonably read on a change from for example 100% A / 0% B to 0% A / 100% B as this would seem to be a "stepwise" (i.e. single step) increase in the blending ratio.

13. It is noted that the Japanese document cited in the 10-5-2000 IDS has been crossed off from the patent documents section of the form 1449 and moved to the other documents section as only an English language abstract was provided for this document.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Geoffrey L. Knable  
Primary Examiner  
Art Unit 1733

G. Knable  
June 13, 2001